

## REMARKS

### *Restriction Requirement*

The Office has set forth a restriction requirement. In particular, the Office Action has set forth four groups of claims: (I) claims 1-12, drawn to a library of viral vectors (class 435, digest 24), (II) claims 13-15, drawn to a method of identifying functionally-related coding sequences (class 435, digest 4), (III) claims 16-35, drawn to a method of constructing a library of viral vectors via intermediate viral genomes and ligation (class 435, digest 47), and (IV) claims 36-53, drawn to a method of constructing a library of viral vectors involving linear DNA molecules and negative selection (class 435, digest 47). The Office Action requires election of a "single invention" for further prosecution. Applicants elect, with traverse, claims 1-12, drawn to a library of viral vectors.

The Office also has set forth an election of species requirement. Applicants thank Examiner Friend for the courtesy of the telephonic interview on March 26, 2003, with Applicants' representative, Heather R. Kissling. Examiner Friend indicated that Applicants are required to elect an ultimate species of a first gene product and a *class* of second gene product selected from RNA or proteins. Applicants elect, with traverse, vascular endothelial growth factor (VEGF) as the first gene product and proteins as the class of second gene product. Applicants understand that, consistent with an election of species requirement, other species will be considered within the "genus" claims encompassing the elected species upon an indication of allowable subject matter with respect to the elected species.

Reconsideration of the requirement for restriction is respectfully requested.

### *Discussion of the Restriction Requirement*

Applicants respectfully request reconsideration of the restriction requirement. There are two separate criteria for a proper requirement for restriction between patentably distinct inventions: (i) the inventions must be independent or distinct as claimed, *and* (ii) there must be a serious burden on the Examiner if restriction is not required. Both of these criteria must exist for a restriction requirement to be proper, and "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, *even though it includes claims to distinct or independent inventions*" (M.P.E.P. § 803, emphasis added).

In the case at hand, the Office fails to meet the above-identified criteria and to present the required supporting evidence and reasoning. The Office has not alleged that there would be a serious burden on the Examiner if restriction or election of species were not required. At the very least, Groups (I) and (II) should be examined together. Groups (I) and (II) are directed to a library of viral vectors and a method of using a library viral vectors for

In re Appln. of KOVESDI et al.  
Application No. 09/780,526

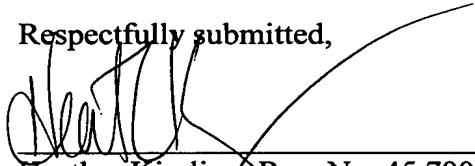
identifying functionally-related coding sequences. It is clear that any search and consideration of the claimed subject matter of Group (II) will necessarily overlap the search and consideration of the claimed subject matter of Group (I). This does not mean that the claims necessarily stand or fall together, but the overlapping relevance of references remains and mitigates against a restriction requirement.

In view of the above, Applicants submit that the requirement for restriction and election of species should be withdrawn and, at the very least, the subject matter of Group (II) should be considered with the subject matter of elected Group (I).

*Conclusion*

For the above reasons, Applicants request withdrawal of the restriction requirement in whole or in part. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned agent.

Respectfully submitted,



---

Heather Kissling, Reg. No. 45,790  
LEYDIG, VOIT & MAYER, LTD.  
Two Prudential Plaza, Suite 4900  
180 North Stetson  
Chicago, Illinois 60601-6780  
(312) 616-5600 (telephone)  
(312) 616-5700 (facsimile)

Date: April 3, 2003